

Cigelske Jr.

U.S. Serial No. 10/065,582

REMARKS

In imposing the three-way restriction, the Examiner states that Groups I, II, and III are unrelated because the "different inventions" have different effects. The Examiner categorized the claims by Groups stating that Group I is drawn to a louver assembly, Group II is drawn to a welding apparatus, and Group III is drawn to a vent assembly. Applicant finds it apparent that the Examiner improperly based his conclusion that the claims in question have different effects based merely on the preamble of the independent claims of the Groups, respectively.

Initially, Applicant objects to the cursory and conclusionary action by the Examiner. The one page "Detailed Action" mainly includes copied and pasted text from the MPEP. The only application of the rule is the conclusionary statement that "in the instant case the different inventions have different effects." However, the Examiner never described what the different inventions are, or what those alleged different effects are. In fact, the Examiner merely states that Group I is drawn to a louver assembly, and Group III is drawn to a vent assembly but never mentions that the vent assembly (claim 11) comprises "a series of louvers..." No analysis of the elements of the claims has been undertaken. As such, the Restriction Requirement is lacking any sustainability on its face. Claims cannot be restricted simply because of the first three words in the independent claims. To further illustrate the minimal review of the claims, the Examiner is directed to claim 13, allegedly in Group III that is "drawn to vent assembly", but actually includes a welder, that the Examiner indicated was a completely separate group - Group II.

As stated by the Examiner, "Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have ... different effects." Emphasis added. MPEP §806.04(A). In imposing the restriction, the Examiner has not shown that the louver assembly of Group I, the welding apparatus of Group II, and the vent assembly of Group III are not disclosed as capable of use together. In fact, the louver or vent assemblies of Groups I and III are both actually disclosed as capable of use with the welding apparatus of Group II. The relation between the louver assembly of Group I or the vent assembly of Group III to the welding apparatus of Group II is disclosed and shown as such in the specification. Specifically, Fig. 1 shows a welding apparatus that utilizes the louvered vent assembly of the present invention. Additionally, the relationship is further addressed in paragraph [0025] through paragraph [0029] of the Detailed Description which discusses that which is shown in Fig. 1. Specifically, referring to the welding

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apparatus 10 shown in Fig. 1, the specification states that "there is a vent opening 28 formed in the front panel 14 of the enclosure 12 and a similar vent opening 30 formed in the rear panel 16 of the enclosure. Within each of the vent openings 28, 30, there are formed a plurality of louvers 32..." As such, the use together of the louver assembly of Group I and the welding apparatus of Group II or the vent assembly of Group III and the welding apparatus of Group II is disclosed in the specification. Therefore, restriction of Group II, containing claims 5-10 from Group I, containing claims 1-4, and Group III, containing claims 11-19, is not proper as the relationship therebetween is fully supported in the specification as stated above.

Regarding the restriction of Group I, asserted to be drawn to a louver assembly, and Group III, asserted to be drawn to a vent assembly; MPEP §806.03 states that "where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should NEVER be required." MPEP §806.03 further states that "this is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition." Claims 1 and 11, the independent claims of Groups I and III, each call for, in part, a plurality of louvers, wherein each louver has a front portion, a rear portion, and an intermediate edge. A complete reading of claims 1 and 11, beyond their respective preambles, shows the essential characteristics contained therein. Therefore, restriction between Group I, containing claims 1-4, and Group III, containing claims 11-19, is not proper and not supportable.

As stated in MPEP §808, "Every requirement to restrict has two aspects: (A) the reasons (*as distinguished from the mere statement of conclusion*) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween ..." The Examiner, by categorizing the claims merely on the basis of preamble language, has not provided Applicant with any reason why the inventions as claimed are independent.

After consideration of the statements outlined above, if the Examiner maintains the restriction between Groups I, II, and III, Applicant requests immediate finality of such restriction to allow Applicant to seek supervisory review.

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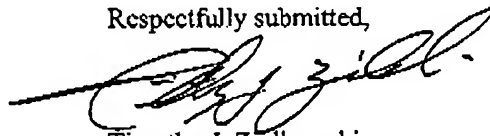
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CONCLUSION

Applicant elects, with traverse, Group III, containing claims 11-19. Additionally, for the reasons outlined above, Applicant requests rejoinder of Group I, containing claims 1-4, and Group II, containing claims 5-10.

The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application.

Respectfully submitted,



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